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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,893	05/25/2001	Gerald Storch	10505-236866	8027
25281	7590	12/23/2004	EXAMINER	
DICKE, BILLIG & CZAJA, P.L.L.C. FIFTH STREET TOWERS 100 SOUTH FIFTH STREET, SUITE 2250 MINNEAPOLIS, MN 55402			KRAMER, JAMES A	
		ART UNIT		PAPER NUMBER
		3627		

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/865,893	STORCH ET AL.
	Examiner James A. Kramer	Art Unit 3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 30 August 2004.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-29 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-29 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tobin in view of Official Notice (with supporting evidence from “AOL, Wal-Mart to team on Net Service”).

Tobin teaches a system for co-branding a web site between two partner companies. (e.g. reference column 9; lines 5-50). Specifically this is used for Internet shopping, but Tobin teaches the system applicable to Intranets defined by a particular class of online customer such as Digital City customers which are a part of America Online’s service (column 16; lines 62-66).

Examiner references Tobin’s example of an Internet site providing floral and gift services; PC Flowers and Gifts. Specifically, Tobin teaches Internet Service Providers display PC Flowers and Gifts Web site pages customized to the requirements of the participating ISP (column 5; lines 4-18).

Tobin further teaches an order page which allows for customizations. Specifically, the customizations manifests in pricing incentives, discounts by percentage or fixed dollar amount. Examiner notes this clearly teaches providing members/shoppers with incentives to access and shop on the co-branded Internet site.

Examiner references Figures 11A-11C, which illustrates co-branded web site of PC Flowers and Gifts and their marketing partner Pathfinder. Examiner notes that in this example Pathfinder represents the ISP and PC Flowers and Gifts the Internet shopping site. Examiner

further notes that Figures 11A-11C teach 1) providing a link to the Internet shopping site (PC Flowers and Gifts) on all pages of the Internet service site(Pathfinder); 2) providing a link to the Internet shopping site (PC Flowers and Gifts) with icon comprising one or more trademark logos of the retailer (PC Flowers and Gifts); 3) providing a tool bar with links to the Internet shopping site (PC Flowers and Gifts).

Examiner notes that claims 11 and 12 require the distribution of the co-branded site from the Internet Shopping site and the ISP respectively. Tobin teaches this distribution as co-branded site is developed (or distributed) based on a request/hypertext link from either the Internet Shopping site (PC Flowers and Gifts) or the ISP (Pathfinder).

Tobin, as described in detail above does not specifically teach: providing members/shoppers with advance notice of events nor providing the member/shopper with discount on subscription fees for the ISP. Examiner takes Official Notice that both of these forms of incentives are old and well known in the art in order to entice members/shoppers to purchase items from a site. Examiner sites the article “AOL, Wal-Mart next to team on Net service” especially the section which discusses co-branded free internet access service. Examiner notes that free represents a “discount”.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the co-branded Internet shopping site of Tobin to include an incentive package that provides member with either advance notice of events sponsored by the retailer (PC Flowers and Gifts) or discounts on subscription fees to the ISP (Pathfinder) in order to entice customers to shop on the co-branded site.

Claims 10-12 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tobin in view of Official Notice.

Claims 10 and 25-26 require the distribution of software via a retail store. Examiner takes Official Notice that it is old and well known in the art for ISPs to distribute their software via retail stores. For example AOL gives away versions of their software at WalMart, Best Buy, Radio Shack, etc in order to reach customers that do not have Internet access. Examiner once again references the article “AOL, Wal-mart next to team on Net services”, specifically the section that states: “If someone is standing in Wal-Mart with a cart full of disks and handing them out, it gives these people who may never have been on the Net a sense of security”. Examiner notes that this clearly provides supporting evidence that it is old and well known to distribute co-branded software at a retail location.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the ISP of Tobin so that their software was distributed at a retail chain, as taught by Official Notice in order to reach customers that do not currently have Internet access.

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (703) 305-5241. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Kramer  
Examiner  
Art Unit 3627

jak

*Michael Cuff* 12/20/04  
MICHAEL CUFF  
PRIMARY EXAMINER